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7 UNITED STATES DISTRICT COURT
8 WESTERN DISTRICT OF WASHINGTON
9 AT SEATTLE

10 0912139 B.C. LTD, et al.,

11 Plaintiffs,

12 v.

13 RAMPION USA INC., et al.,

14 Defendants.

CASE NO. C18-1464JLR

ORDER ON PLAINTIFFS'
MOTION TO STRIKE
DEFENDANTS' INVALIDITY
CONTENTIONS

15 **I. INTRODUCTION**

16 Before the court is Plaintiffs 0912139 B.C. Ltd. ("B.C. Ltd.") and Pakage Apparel,
17 Inc.'s ("Pakage") (collectively, "Plaintiffs") motion to strike portions of Rampion USA
18 Inc. and Rampion Enterprises Ltd.'s (collectively, "Defendants") invalidity contentions.
19 (Mot. (Dkt. # 33).) Defendants oppose the motion. (Resp. (Dkt. # 40).) Plaintiffs filed a
20 reply.¹ (Reply (Dkt. # 43).) The court has reviewed the motion, the parties' submissions

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22 ¹ Additionally, Defendants filed a surreply in which they move to strike portions of
Plaintiffs' reply, portions of the declaration of Nathan Brunette, and Exhibit 1 to Mr. Brunette's

1 concerning the motion, the relevant portions of the record, and the applicable law. Being
2 fully advised,² the court GRANTS in part and DENIES in part Plaintiffs' motion to strike
3 Defendants' invalidity contentions.

4 II. BACKGROUND

5 This is a patent infringement dispute. (*See generally* Compl. (Dkt. # 1).) B.C.
6 Ltd. owns, and Pakage is licensed to practice, U.S. Patent No. 9,687,030 ("the '030
7 Patent") and U.S. Patent No. 10,034,496 ("the '496 Patent") (collectively, "the Patents"),
8 which are directed to an undergarment for men. (*See id.* ¶¶ 19-24; *see also id.* ¶ 19, Ex.
9 3; *id.* ¶ 20, Ex. 4.) Plaintiffs allege that Defendants make and sell men's underwear that
10 infringes the Patents. (*See id.* ¶¶ 31-64.) Defendants deny infringement and contend that
11 all the asserted claims of both Patents are invalid. (*See* Rampion USA Answer (Dkt.
12 # 18) ¶¶ 32-61; Rampion Enterprises Answer (Dkt. # 23) ¶¶ 32-61.)

13 On January 28, 2019, Defendants served their preliminary invalidity contentions.³
14 (Meiklejohn Decl. (Dkt. # 27) ¶ 2; *see also* Park Decl. (Dkt. # 34) ¶ 2, Ex. 1 ("Invalidity
15 Contentions").) Several weeks later, on March 21, 2019, Plaintiffs filed the present
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17 declaration. (Surreply (Dkt. # 46); *see also* Brunette Decl. (Dkt. # 44) ¶ 9, Ex. 1.) The court
18 addresses Defendants' surreply below. *See infra* § III.B.3 at n.5.

19 ² Defendants request oral argument on the motion (Resp. at title page), but the court finds
20 that oral argument would not be helpful to its disposition of the motion, *see* Local Rules W.D.
21 Wash. LCR 7(b)(4).

22 ³ Shortly thereafter, the parties filed, and the court granted, a stipulated motion to allow
Defendants to amend their preliminary invalidity contentions to assert an additional invalidity
contention under 35 U.S.C. § 112. (*See* Stip. Mot. to Am. (Dkt. # 26); 2/6/19 Order (Dkt. # 28);
see also Park Decl. (Dkt. # 34), ¶ 3, Ex. 2.) That amendment has no bearing on the present
motion. (*See* Mot. at 1 n.1.)

1 motion to strike portions of Defendants’ invalidity contentions for failure to comply with
2 Local Patent Rule 121. (*See generally* Mot.); Local Rules W.D. Wash. LPR 121.

3 **III. ANALYSIS**

4 **A. Legal Standard**

5 The Western District of Washington has adopted local patent rules that “require
6 parties to state early in the litigation and with specificity their contentions with respect to
7 infringement and invalidity.” *O2 Micro Int’l Ltd. v. Monolithic Power Sys., Inc.*, 467 F.3d
8 1355, 1359 (Fed. Cir. 2006). These rules are “designed to require parties to crystallize
9 their theories of the case early in the litigation and to adhere to those theories once they
10 have been disclosed.” *REC Software USA, Inc. v. Bamboo Sols. Corp.*, No.
11 C11-0554JLR, 2012 WL 3527891, at *2 (W.D. Wash. Aug. 15, 2012) (quoting *O2*
12 *Micro*, 467 F.3d at 1366 n.12). District courts have broad discretion to enforce local
13 patent rules. *See, e.g., Howmedica Osteonics Corp. v. Zimmer, Inc.*, 822 F.3d 1312, 1320
14 (Fed. Cir. 2016).

15 Under Local Patent Rule 121, a party’s invalidity contentions must comply with
16 specific requirements. Local Rules W.D. Wash. LPR 121. Three of those requirements
17 are relevant to Plaintiffs’ motion. First, the invalidity contentions must identify “[e]ach
18 item of prior art that allegedly anticipates each Asserted Claim or renders it obvious.” *Id.*
19 LPR 121(b). To that end, “[p]ublic uses or sales shall be identified by specifying the item
20 offered for sale or publicly used or known, the date the offer or use took place or the
21 information became known, and the identity of the person or entity which made the use
22 or which made and received the offer, or the person or entity which made the information

1 known or to whom it was made known.” *Id.* Second, the invalidity contentions must
2 state “[w]hether each item of prior art anticipates each Asserted Claim or renders it
3 obvious.” *Id.* LPR 121(c). “If a combination of items of prior art makes a claim obvious,
4 each such combination must be identified.” *Id.* Finally, the invalidity contentions must
5 include “[a] chart identifying where specifically in each alleged item of prior art each
6 element of each Asserted Claim is found” *Id.* LPR 121(d). Similarly, this court’s
7 Standing Patent Order requires a party’s invalidity contentions to include “a chart that
8 identifies where in each piece of prior art each element of each asserted claim is found.”
9 SPO, <https://www.wawd.uscourts.gov/sites/wawd/files/RobartStandingPatentOrder.pdf>,
10 at 2.

11 As this court has recognized, Local Patent Rule 121 closely tracks the language of
12 a similar local patent rule in the Northern District of California. *REC Software*, 2012 WL
13 3527891, at *5 n.4 (citing N.D. Cal. Local Patent Rule 3-3). Accordingly, the court finds
14 persuasive authority from the Northern District of California involving motions to strike
15 invalidity contentions for failure to comply with the local patent rules. *See id.* at *2
16 (“[B]ecause of the strong similarity between the local patent rules of the Northern District
17 of California and the Local Patent Rules of this District, the court views the Northern
18 District of California cases interpreting their own local patent rules to be of assistance in
19 this court’s effort to fashion its own standard.”).

20 **B. Plaintiffs’ Motion**

21 Plaintiffs move to strike Defendants’ invalidity contentions on four grounds: (1)
22 Defendants “purport to preserve a right to rely on unidentified references, unidentified

1 portions of references, and unidentified combinations of references”; (2) Defendants
2 identify “four different categories of products” that allegedly constitute prior art but fail
3 to identify the “who, what, and when of the alleged use or sale” of those products, as
4 required under Local Patent Rule 121(b); (3) Defendants’ lists of references and claim
5 charts do not identify obviousness combinations with the level of specificity mandated by
6 Local Patent Rule 121(c); and (4) Defendants’ claim charts do not identify where each
7 claim element may be found in each alleged item of prior art, in violation of Local Patent
8 Rule 121(d). (Mot. at 1, 4.)

9 Defendants insist that the invalidity contentions served on January 28, 2019,
10 satisfy the Local Patent Rules. (Resp. at 1.) Additionally, alongside their response to
11 Plaintiffs’ motion, Defendants submitted proposed amended invalidity contentions that
12 purport to address Plaintiffs’ complaints and “clarify [Defendants’] already-disclosed
13 positions.” (*Id.* at 1-2; *see also* Kolter Decl. (Dkt. # 41) ¶ 14, Ex. 1 (“Prop. Am.
14 Invalidity Contentions”).) Defendants request that, should the court determine that
15 Defendants’ invalidity contentions are deficient, Defendants be granted leave to use their
16 amended invalidity contentions or further amend. (Resp. at 4.)

17 The court addresses Plaintiffs’ challenges in turn.

18 1. Reservations of Right

19 Plaintiffs move to strike various “reservations of right” throughout Defendants’
20 invalidity contentions. (*See* Mot. at 7-9.) According to Plaintiffs, those clauses purport
21 to preserve Defendants’ right “to rely on unidentified references, unidentified portions of
22 references, and unidentified combinations of references.” (*Id.* at 7.) Plaintiffs identify

1 approximately 14 paragraphs or portions of paragraphs in which such reservations of
2 right appear. (*See* Invalidity Contentions at 2-4, 7, 8, 16 (highlighted portions).)
3 According to Plaintiffs, these clauses “are improper because they do not provide the
4 specific information required by LPR 121.” (Mot. at 8.)

5 Many of the reservations of right Plaintiffs identify are unproblematic. For
6 instance, Defendants reserve the right to supplement or amend their invalidity contentions
7 to address “newly discovered art, new constructions of the terms of the Patents[], and/or
8 new theories of invalidity.” (Invalidity Contentions at 2.) Similarly, Defendants reserve
9 the right to amend their invalidity contentions should Plaintiffs “modify any assertion or
10 contention in their Infringement Contentions.” (*Id.* at 3.) As Defendants correctly
11 observe, any such amendment to its invalidity contentions would be governed by Local
12 Patent Rule 124, which requires “a timely showing of good cause.” Local Rules W.D.
13 Wash. LPR 124; (*see also* Resp. at 5.) Put otherwise, the above-cited clauses do nothing
14 more than acknowledge Defendants’ right to move for leave to amend their invalidity
15 contentions at a later date. (Resp. at 5.) Reservations of right to that effect do not
16 contravene Patent Rule 121. *See* Local Rules W.D. Wash. LPR 124 (good cause to
17 amend may include claim construction and recent discovery of material prior art); *see*
18 *also Medtronic, Inc. v. AGA Med. Corp.*, No. C-07-0567-MMC (EMC), 2009 WL
19 513370, at *4 (N.D. Cal. March 2, 2009) (denying a motion to strike upon finding that
20 the local patent rules did not “require[] a party to assert a claim of invalidity which is
21 only conditional and contingent on the opposing party’s position”).

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1 However, Plaintiffs identify other reservations of right—in Defendant’s original
2 invalidity contentions as well as their proposed amended contentions—of a different
3 character. In those clauses, Defendants appear to reserve a right to rely upon unidentified
4 or uncited portions of certain references, even absent amendments to their invalidity
5 contentions. For example, with respect to their invalidity claim charts, Defendants state:

6 Defendants have endeavored to identify exemplary disclosures in the prior
7 art references that satisfy the associated claim elements. . . . The citations
8 and quotations in the charts are representative and should not be construed
 as limiting. For each reference, Defendants intend to rely on the reference in
 its entirety, rather than only on the identified excerpts thereof.

9 (Invalidity Contentions at 7; Prop. Am. Invalidity Contentions at 8.) Additionally,
10 Defendants seek to “reserve the right to rely upon foreign counterparts of U.S. patents
11 identified in these Preliminary Invalidity Contentions and U.S. and foreign patents, patent
12 applications, articles and publications corresponding to the patents, products, articles, and
13 publications identified in these Preliminary Invalidity Contentions.” (Invalidity
14 Contentions at 4; Prop. Am. Invalidity Contentions at 4.)

15 The court understands why these and similar reservations of right have raised
16 Plaintiffs’ hackles: rather than simply preserving Defendants’ right to amend the
17 invalidity contentions, these clauses may be read to safeguard Defendants’ ability to rely
18 on unnamed prior art references or uncited portions of references down the road, even
19 absent an amendment. Defendants, however, cannot effect an end-run around Local
20 Patent Rule 124’s good cause requirement by incorporating by reference uncited material
21 or reserving a right to rely upon uncited material. *See Ironworks Patents LLC v.*
22 *Samsung Elecs. Co., Ltd.*, No. 17-cv-01958-HSG(JSC), 2017 WL 4573366, at *3 (N.D.

1 Cal. Oct. 13, 2017) (striking the defendant’s list of 29 “Additional References” where the
2 defendant sought to reserve the right to “rely on these references as invalidating prior
3 art,” depending on subsequent developments in the litigation); *see also Mitsubishi Elec.*
4 *Corp. v. Sceptre, Inc.*, No. 2:14-cv-04994-ODW (AJWx), 2015 WL 2369557, at *2-3
5 (C.D. Cal. May 18, 2015) (striking portions of invalidity contentions that “purported to
6 reserve the right to rely upon cited portions of th[e] references” cited in the claim charts).

7 The court thus GRANTS Plaintiffs’ motion to strike all clauses in the invalidity
8 contentions that purport to allow Defendants to rely on uncited references or uncited
9 portions of references as invalidating prior art. The court DENIES Plaintiffs’ motion to
10 strike any reservations of right that acknowledge Defendants’ prerogative to move to
11 amend their invalidity contentions in accordance with Local Patent Rule 124.

12 2. Failure to Identify Specific Products

13 Plaintiffs also seek to strike all “reference[s] to [the] alleged prior use or sale” of
14 four categories of underwear “products” that Defendants have identified as alleged prior
15 art: (1) “Andrew Christian products with ‘Show-It’ technology” (2) “Saxx underwear
16 products,” (3) “Body Tech line from UnderGear,” and (4) “Lift Collection.” (Mot. at 4;
17 *see also* Invalidity Contentions at 6.) Plaintiffs assert that, because Defendants have
18 identified these four categories of products by company name only, rather than “product
19 name,” Defendants’ references to and reliance on these product categories violate Local
20 Patent Rule 121(b). (Mot. at 4-5.)

21 Defendants’ invalidity contentions identify alleged prior art in two parts: (1) prior
22 art “[r]eferences,” which cite various patents, and (2) prior art “[p]roducts,” which list the

four categories of underwear products Plaintiffs highlight. (Invalidity Contentions at 6.)

Specifically, the invalidity contentions identify prior art products as follows:

Product	On-Sale Date
Andrew Christian products with “Show-It” technology (also referred to as Show-It Technology 2.0) (“Andrew Christian Show-It Underwear”)	At least as early as March 6, 2009 (see documents produced)
Saxx underwear products	At least as early as March 2009 <i>See</i> http://www.youtube.com/watch?v=mfk3tJzZKPs (“The Evolution of Saxx”) (see documents produced)
Body Tech line from UnderGear featuring an “enhancement pouch”	At least as early as May 1, 2009 (see documents produced)
2(x)ist products with “dual lifting technology” (Lift Collection)	Currently unknown (see documents produced)

(*Id.*) Defendants’ proposed amended invalidity contentions include essentially the same chart, albeit with specific references to documents produced and the date of production.

(*See* Prop. Am. Invalidity Contentions at 6-7.) Additionally, the claim charts that accompany Defendants’ invalidity contentions feature numerous references to the four

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1 categories of products. (*See generally* Park Decl. ¶ 4, Ex. 3 (“Invalidity Charts”) at
2 Charts A1-G2; Prop. Am. Invalidity Contentions at Charts A1-G2.⁴)

3 Defendants argue that striking references to the four categories of prior art
4 products “would be premature and inconsistent with the notice policy behind invalidity
5 contentions.” (Resp. at 7.) Defendants explain that they identified the alleged prior art
6 products “[a]fter a diligent search . . . based on third party web pages and the Internet
7 Archive,” and that “[t]he products described in those pages are almost a decade old and
8 no longer readily available.” (*Id.* at 6.) Defendants further represent that they have
9 “prepared third party subpoenas and letters rogatory to try to obtain samples of these
10 products including specific dates of sales and use, entities involved, and product names or
11 model numbers,” but, as of the filing of their response, Defendants “included all the
12 product information in [their] possession in [their] Contentions.” (*Id.* at 6-7.) Defendants
13 state that they will seek leave to amend their invalidity contentions “to add newly
14 discovered information once, and if, it is received.” (*Id.*)

15 The court agrees with Plaintiffs that, with respect to the identification of prior art
16 “products,” neither Defendants’ existing invalidity contentions nor their proposed
17 amended invalidity contentions comply with Local Patent Rule 121(b). Local Patent
18 Rule 121(b) requires that a party identify public uses or sales of the claimed invention
19 with a degree of precision not present in Defendants’ existing disclosure of alleged prior
20 art products—namely, Defendants fail to identify any specific products that fall within

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22 ⁴ When citing the Invalidity Charts, the court cites the chart number (*e.g.*, “A1”) followed
the page number that appears in bold in the top-right corner of the chart.

1 the four categories. *See* Local Rules W.D. Wash. LPR 121(b) (stating that “[p]ublic uses
2 or sales shall be identified by specifying the item offered for sale or publicly used or
3 known”); (Invalidity Contentions at 6.) As Plaintiffs point out, the “documents
4 produced” to which Defendants refer in their invalidity contentions indicate that the listed
5 companies offered or offer several different products, none of which are specified in
6 Defendants’ invalidity contentions or the accompanying claim charts. (*See* Mot. at 5; *see*,
7 *e.g.*, Invalidity Charts, Chart A1 at 12-18 (referring generally to Andrew Christian
8 boxers, briefs, and an unidentified sketch of an Andrew Christian product).)

9 Defendants essentially concede that their product references are deficient. (*See*,
10 *e.g.*, Resp. at 11 (“As to the product prior art, Rampion simply does not have it—but it
11 provided everything it does have . . .”).) Defendants’ “lack of information to support
12 [their contentions] does not justify non-compliance” with Local Patent Rule 121(b). *See*
13 *Rambus Inc. v. NVIDIA Corp.*, No. C-08-03343 SI, 2011 WL 13249391, at *3 (N.D. Cal.
14 Nov. 29, 2011) (ordering the defendant to “complete its investigation, and provide the
15 information required by [the local patent rules], or . . . remove the prior art references for
16 which it lacks the required information”). If Defendants discover evidence regarding a
17 product sufficient to support its invalidity contentions, they may move for leave to amend
18 their invalidity contentions. At this time, however, the court GRANTS Plaintiffs’ motion
19 to strike all references to the four product categories identified above, both in
20 Defendants’ invalidity contentions and the accompanying claim charts, for failure to
21 comply with Local Rule 121(b).

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1 3. Obviousness Combinations

2 Local Patent Rule 121(c) requires that a party disclose “[w]hether each item of
3 prior art anticipates each Asserted Claim or renders it obvious,” and, “[i]f a combination
4 of items of prior art makes a claim obvious, each such combination must be identified.”
5 Local Rules W.D. Wash. LPR 121(c). Defendants’ obviousness contentions have two
6 parts: first, 14 lists of references—seven per Patent—enumerated in section III of the
7 invalidity contentions; and second, hundreds of pages of claim charts that purport to set
8 forth Defendants’ obviousness combinations in greater detail. (*See Invalidity*
9 *Contentions* at 9-15; *Invalidity Charts* at A1-G2.) Plaintiffs argue that both the lists of
10 references and the accompanying claim charts fail to disclose the precise combinations of
11 prior art on which Defendants will rely to show obviousness and fail to specify which
12 patent claims are implicated by those combinations. (Mot. at 10-11; *see also* Reply at
13 2-4.) Defendants respond that the lists of references merely summarize the prior art
14 references described in each claim chart, and that the claim charts adequately identify the
15 combinations of prior art on which Defendants will rely to establish obviousness. (Resp.
16 at 7.)

17 The court agrees with Plaintiffs that the lists of references enumerated in
18 Defendants’ invalidity contentions are deficient. The lists set forth “buckets” of
19 references that would support virtually endless permutations of prior art combinations.
20 (*See Invalidity Contentions* at 9-15.) That approach is consistently rejected in the case
21 law and fails to comply with Local Patent Rule 121(c). *See, e.g., Slot Speaker*, 2017 WL
22 235049, at *6-7; *Ironworks*, 2017 WL 4573366, at *1-3. Accordingly, the court

1 GRANTS Plaintiffs’ motion to strike the lists of references in section III of Defendants’
2 invalidity contentions.

3 The accompanying claim charts are less obviously deficient. Defendants provide a
4 total of 14 claim charts to address anticipation and obviousness, with each chart relating
5 to a primary reference. Each chart consists of two columns: (1) on the left, each asserted
6 claim of each Patent is broken into discrete claim elements that occupy separate cells; and
7 (2) on the right, Defendants identify “[e]xemplary” disclosures in prior art that
8 correspond to each claim element. (*See* Invalidity Contentions at Charts A1-G2.) There
9 are two problems with this arrangement. First, Local Patent Rule 121(c) does not permit
10 the disclosure of merely “exemplary” combinations of prior art. Defendants must
11 disclose specific obviousness combinations. *See* Local Rules W.D. Wash. LPR 121(c).
12 Second, although the claim charts purport to assert obviousness combinations on a claim
13 element-by-claim element basis, the charts include so many potential combinations of
14 alleged prior art that they fail to reasonably apprise Plaintiffs of the obviousness
15 combinations on which Defendants intend to rely.⁵

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17 ⁵ In their reply, Plaintiffs provide arithmetic not present in their motion to emphasize this
18 point. (*See* Reply at 3.) Plaintiffs argue that the references cited with respect to claim 1 of the
19 ’496 Patent, as set forth in chart D-1 of Defendants’ proposed amended invalidity contentions,
20 could be combined in “more than 480 total different iterations” for that claim alone. (*Id.*; *see*
21 *also* Brunette Decl. ¶¶ 7-10.) According to Plaintiffs, “Defendants’ “14 charts across all asserted
22 patent claims amount to over 66,000 potential combinations of references against specific patent
claims.” (Reply at 3 (emphasis omitted).) Defendants move to strike these portions of Plaintiffs’
reply and Mr. Brunette’s declaration on the ground that “[t]he argument that there are too many
combinations was never made in Plaintiffs’ opening papers, but it certainly could have been
made then.” (Surreply at 1.) The court finds Defendants’ objection misplaced. Plaintiffs did
argue in their motion that Defendants’ invalidity contentions “include any number of *unidentified*
combinations”—albeit in the context of the lists of references—and asserted their calculations in
direct response to Defendants’ argument that the claim charts “identify asserted specific

1 The court acknowledges that an accused infringer is not required to “spell out in
2 exact detail every particular combination it intends to assert.” *Slot Speaker*, 2017 WL
3 235049, at *6 (quoting *Fujifilm Corp. v. Motorola Mobility LLC*, No. 12-cv-03587-WHP,
4 2015 WL 757575, at *28 (N.D. Cal. Feb. 20, 2015)). Under one line of authority, courts
5 have found that a defendant satisfies its obligation to disclose obviousness contentions,
6 even if its approach results in “billions of possible obviousness combinations,” as long
7 as the defendant “reasonably specifies” the possible combinations of prior art references
8 that allegedly render the asserted claims obvious. *Rambus*, 2011 WL 13249391, at *5-6
9 (quoting *Avago*, 2007 WL 951818, at *4); *see also Keithley v. The Homestore.com, Inc.*,
10 553 F. Supp. 2d 1148, 1150 (N.D. Cal. 2008). In those cases, the defendants organized
11 prior art references into groups and articulated an overarching theory of obviousness that
12 applied to “each and every possible combination[]” of prior art within the groups. *Avago*,
13 2007 WL 951818, at *4; *Rambus*, 2011 WL 13249391, at *5-6; *Keithley*, 553 F. Supp. 2d
14 at 1150.

15 Here, Defendants have not adopted a “grouping” approach that reasonably
16 apprises Plaintiffs of their obviousness contentions. Rather, Defendants have charted
17 various primary references in conjunction with multiple additional references per claim
18 element, giving rise to an unreasonably large assortment of potential combinations of
19 prior art untethered to any discernable theory or theories of obviousness. This approach
20 fails to satisfy the purpose of Local Patent Rule 121(b)—to put Plaintiffs on reasonable

21 _____
22 combinations on a claim element-by-claim element basis.” (Resp. at 7.) The court thus DENIES
Defendants’ motion.

1 notice of the possible combinations of prior art references that allegedly render the
2 asserted claims obvious. *See* Local Rules W.D. Wash. LPR 121(c). “[T]o the extent that
3 [Defendants’] approach involves grouping of prior art, [Defendants] must explain which
4 prior art references fall into a particular group, as well as the theory of obviousness for
5 combinations from particular groups.” *See Slot Speaker*, 2017 WL 235049, at *7
6 (striking obviousness contentions where the defendant relied upon a primary reference
7 “in combination with the other charted prior art references,” without specifying whether
8 the defendant intended to rely upon “any, some, or all of the charted prior art
9 references”).

10 The court thus GRANTS Plaintiffs’ motion to strike Defendants’ obviousness
11 contentions, with leave to amend consistent with the above discussion.

12 4. Specificity of Prior Art Claim Charts

13 Under Local Patent Rule 121(d), a party defending against a claim of infringement
14 must provide a chart for each item of alleged invalidating prior art that specifically
15 identifies where each element of each asserted claim of the patents-in-suit is found.
16 Local Rules W.D. Wash. LPR 121(d). Likewise, the court’s Standing Patent Order
17 requires “a chart that identifies where in each piece of prior art each element of each
18 asserted claim is found.” SPO at 2. Plaintiffs argue that Defendants’ claim charts fail to
19 satisfy these requirements.

20 Courts in the Northern District of California have concluded that the level of
21 specificity required by a substantially similar local patent rule is the same as that required
22 for disclosure of infringement contentions. “Broad or general disclosures are

1 insufficient.” *Slot Speaker*, 2017 WL 235049, at *2 (internal quotation marks and
2 citation omitted); *see also Largan Precision Co. Ltd. v. Genius Elec. Optical Co.*, No.
3 13-cv-02502-JD, 2012 WL 6882275, at *4 (N.D. Cal. Dec. 5, 2014) (“The requirement
4 that the invalidity contentions disclose whether each item of prior art anticipates each
5 asserted claim or renders it obvious would be a dead letter if parties could avoid it with
6 broad disclaimers.”).

7 To support their argument that Defendants’ claim charts lack the specificity
8 required by Local Patent Rule 121(d), Plaintiffs highlight chart D1’s disclosures
9 regarding the fourth limitation of claim 1 of the ’496 Patent. (Mot. at 11.) Defendants
10 identify the fourth element of claim 1 of the ’496 Patent as follows:

11 [1.4] the stretch panel being resiliently elastic both in a direction between the
12 top edge and the bottom edge and in a direction between the side edges, the
13 stretch panel having a length when unstretched smaller than a length
14 measured along the front portion between the top and bottom locations and
15 a width when unstretched smaller than a width measured along the front
16 portion between the side seams such that the front portion is gathered from
17 side-to-side and top-to-bottom by the stretch panel and defines a
18 three-dimensional pouch between the stretch panel and the front portion for
19 receiving the wearer’s genitals and holding the wearer’s genitals while the
20 garment is being worn.

21 (Invalidity Contentions, Chart D1 at 31-32.)

22 In locating this claim element in the asserted references, Defendants merely
reproduce large portions of, and figures from, the references, without stating how those
excerpts disclose each element of the limitation. (*See id.* at 31-48.) In fact, Defendants
copy and paste the very same portions of the references with respect to multiple elements
within the claim limitation. (*Id.* at 31-46 (repeating three times the same excerpted text

1 and figures from a reference, without indicating where each claim element is found).)
2 Defendants’ proposed amended chart D1 suffers the same deficiencies. Defendants
3 merely highlight portions of the excerpted references and add arrows pointing to specific
4 areas of the figures. This approach falls short of the obligation imposed by Local Patent
5 Rule 121(d).

6 The court thus GRANTS Plaintiffs’ motion to strike the aforementioned portions
7 of chart D1 and all other portions of the claim charts that fail to identify where each claim
8 limitation may be found in the alleged prior art, with leave to amend consistent with the
9 principles discussed above.⁶

10 5. Leave to Amend

11 Plaintiffs argue that the court should deny Defendants leave to amend because
12 “[Defendants] ha[ve] already taken [their] own leave to do so (in the form of the
13 [Amended] Contentions), and ha[ve] provided proposed amended contentions that also
14 fail to comply with the [Local Patent Rules] and the [Standing Patent Order].” (Reply at
15 //

17 ⁶ Plaintiffs also argue that, “because Defendants organized the Charts around *groups* of
18 references (rather than a chart for each reference), Plaintiffs cannot discern what claim elements
19 are found in a given reference without reviewing each of the seven Charts per patent.” (Mot. at
20 12.) Plaintiffs suggest that Local Patent Rule 121(d) requires that Defendants provide one chart
21 per reference, in which Defendants identify where each element of each asserted claim is found
22 in that particular reference. (*Id.*) Plaintiffs cite no support for that interpretation of the Local
Patent Rules or similar rules in other districts (*see generally id.*), and the court declines to adopt
it. Local Patent Rule 121(d) may envision the provision of reference-by-reference claim charts,
but it does not expressly require that the “chart identifying where specifically in each alleged
item of prior art each element of each asserted claim is found” be separate from any charts that
disclose anticipation and obviousness contentions. *See generally* Local Rules W.D. Wash. LPR
121(d).

6.) According to Plaintiffs, granting leave to amend would only allow Defendants “another bite at the apple” to correct its deficient contentions. (*Id.*)

The court concludes that leave to amend is appropriate here.⁷ First, the court acknowledges that the Local Patent Rules impose a strict timeline on accused infringers’ invalidity contentions. *See* Local Rules W.D. Wash. LPR 121 (providing that an accused infringer must serve its invalidity contentions within 30 days of service upon it of the plaintiff’s infringement contentions). Although that timeline does not excuse non-compliance with the Rules’ substantive requirements, a party is better able to clarify and streamline its invalidity contentions as the litigation progresses. Defendants should be afforded an opportunity to do so. Moreover, this case is in its relatively early stages. Expert witness reports are not due until the end of next month, discovery closes in three months, and trial is some eight months away. (*See* Sched. Order (Dkt. # 22) at 2.) Plaintiffs will not suffer undue prejudice if Defendants are granted leave to amend.

The court thus GRANTS Defendants leave to amend their invalidity contentions, consistent with the discussion herein, and ORDERS Defendants to serve their newly amended invalidity contentions on Plaintiffs within 30 days of the filing date of this order. The court notes that, in their reply, Plaintiffs allege that Defendants added to their proposed amended invalidity contentions additional, new references, which were not specifically related to the deficiencies identified in Plaintiffs’ motion to strike. (Reply at

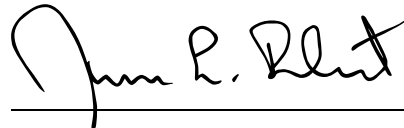
⁷ A party requesting leave to amend in response a motion to strike need not make the same showing of “good cause” that must support a motion to formally amend its contentions. *Slot Speaker*, 2017 WL 235049, at *9.

1 3-4.) Should Defendants seek to add new material to their forthcoming amended
2 invalidity contentions, as opposed to clarifying their existing invalidity theories, they
3 must seek the court's leave pursuant to Local Patent Rule 124. Further, in the event
4 Plaintiffs believe Defendants' newly amended invalidity contentions remain deficient,
5 Plaintiffs must meet and confer with Defendants to attempt to resolve the issues before
6 filing any additional motions to strike.

7 **IV. CONCLUSION**

8 For the foregoing reasons, the court GRANTS in part and DENIES in part
9 Plaintiffs' motion to strike Defendants' invalidity contentions. (Dkt. # 33.) The court
10 further GRANTS Defendants leave to amend their invalidity contentions, consistent with
11 the discussion herein, within 30 days of the filing date of this order.

12 Dated this 15th day of July, 2019.

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15 The Honorable James L. Robart
16 U.S. District Court Judge
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